

### **Remarks**

Reconsideration of the issues raised in the Office Action dated January 21, 2009 is respectfully requested in light of the amendments to the specification and the claims, and the remarks presented herewith. The issues are addressed below in the order in which they are presented in the Office Action.

#### **Title**

The title has been objected to as being "not descriptive."

In the amendments to the Specification presented herewith, a new title is presented that is indicative of the invention to which the claims are directed.

#### **Specification**

The abstract of the disclosure has been objected to as containing trademarks which have not been identified properly.

In the amendments to the Specification presented herewith, the abstract of the disclosure has been amended to more properly identify the trademark used therein.

The disclosure has also been objected to as lacking section headings.

In the amendments to the Specification presented herewith, the disclosure has been amended to include proper section headings.

Additionally, the use of the trademark WINDOWS in the application has been identified as requiring correction, and the examiner has encouraged the applicants to carefully check the Specification to ensure that no other trademarks have been used without proper capitalization and accompaniment by generic terminology.

In the amendments to the Specification presented herewith, the Specification has been amended to capitalize all known trademarks and to use generic terminology therewith.

It is respectfully submitted that amendments to the Specification adequately address the identified objections to the Specification, and it is respectfully requested that the stated objections be withdrawn.

#### **Claim Objections**

The objections raised with respect to claims 2, 5, 14, 15 and 24 have been addressed in the amendments to the Claims presented herewith. Additionally, misspellings have also been corrected in claims 22 and 25.

It is respectfully submitted that amendments to the Claims properly address the identified objections to the claims, and it is respectfully requested that the objections be withdrawn.

#### **Claim Rejections – 35 U.S.C. 102**

Claims 1 – 3, 5, 14 – 17, 19 – 23, 25, 34 – 38, and 41 – 43 have been rejected under 35 U.S.C. 102(b) as being anticipated by Ohashi et al. (U.S. Patent No. 5,761,309) (“Ohashi”). This rejection is respectfully traversed, but independent claims 1, 21 and 42 have been amended to further clarify the distinctions between the invention recited in the Claims and the Ohashi reference.

Claim 1, as amended, recites, *inter alia*, “the authentication process for authenticating the transaction by that user with the data processing apparatus not requiring use of the user’s telecommunications terminal nor requiring the telecommunications terminal to be actually authenticated by that information in relation to the telecommunications system.” Claim 1, as amended, clarifies that the data processing apparatus and the telecommunications terminal (i.e., telecommunications handset) are distinct technical elements of the claimed invention.

It is stated in the Office Action, with respect to claim 1, that Ohashi discloses “a device (card reader 11) for connection to a data processing apparatus (client terminal 12), ... the

authentication storage means (smart card 10) being registered with a telecommunications system (authentication center) which includes authenticating means (AuC data) and for which the user has a telecommunications terminal (client terminal 12) ...” (Office Action, page 4, lines 8 – 14). Thus, the client terminal 12 of Ohashi is read in the Office Action as both the data processing apparatus and the telecommunications terminal of claim 1.

It is respectfully submitted that, as discussed above, the data processing apparatus and the telecommunications terminal recited in claim 1, as amended, are distinct elements, such that the authentication process for authenticating the transaction by that user with the data processing apparatus does not require use of the telecommunications terminal nor require the telecommunications terminal to be authenticated. Thus, for at least this reason, it is respectfully submitted that claim 1 is not anticipated by Ohashi.

Further, amended claim 1 also recites, *inter alia*, “and wherein the device controls access to the authentication information.”

As recited in claim 1, the device has authentication storage means which stores predetermined authentication information. The authentication storage means are registerable with a common telecommunications system for which the users have respective telecommunications terminals (i.e., handsets). The authentication process for authenticating a subsequent transaction by a user with data processing apparatus includes the step of operatively associating the user's authentication storage means with the data processing apparatus. The authentication process is carried out via a communications link with the common telecommunication system, the authentication process being carried out by authenticating means incorporated in the telecommunications system. The authentication process involves the use of the predetermined authentication information stored on the authentication storage means.

Importantly, the authentication information stored by the authentication storage means corresponds to information which is used to authenticate the user's telecommunications handset with the common telecommunication system. However, the authentication process for authenticating the transaction by the user with the data processing apparatus does not require use of the user's telecommunication handset nor does it require the telecommunications handset to be actually authenticated by the information in relation to the telecommunications system.

The device, as recited in claim 1, makes use of the predetermined authentication information on the authentication storage means and uses this for authenticating a transaction with data processing apparatus where no telecommunications handset is involved. In the embodiment described in the Specification, the user's SIM (authentication storage means) performs authentication using the predetermined authentication information without involvement of the user's telecommunications terminal. There is no suggestion of such an arrangement in Ohashi.

The present application pre-dates any published proposal of which the Applicant is aware where the SIM/authentication storage means is used separately from the telecommunications terminal. That is, the predetermined authentication information on the SIM, corresponding to information that is used to authenticate a telecommunications terminal with a common telecommunications network, is used to authenticate a transaction with a data processing apparatus by operatively associating the authentication storage means/SIM with the data processing apparatus, without the user's telecommunications terminal.

At the priority date of the present application, there was a prejudice in the mobile telecommunications art against using an authentication storage means/SIM separately from a telecommunications terminal. Such a use of a SIM was never envisaged prior to the present

application. The present invention provides a significant technical advantage of providing secure authentication, for example using the challenge and response SIM authentication between the SIM and the authenticating means of the common telecommunications system, to authenticate a transaction using a data processing apparatus with which the authentication storage means/SIM is operatively coupled. The authentication requires processing of the challenge and response to be performed at both ends of the communication channel over which the transaction is authenticated. The present invention enables secure and reliable authentication of transactions to be performed without developing new authentication infrastructure.

Independent claims 21 and 42 have been amended to recite similar limitations to those described above with respect to claim 1, and are allowable for at least the reasons discussed with respect to the allowability of claim 1.

Further, dependent claims 2 – 3, 5, 14 – 17, 19 – 20, 22 – 23, 25, 34 – 38, 41, and 43 each depend from one of independent claims 1, 21 and 42 and are also allowable for at least the reasons discussed above.

#### **Claim Rejections – 35 U.S.C. 103**

Claims 18, 39 – 40, 46 – 51, and 53 have been rejected as being unpatentable over Ohashi. Claims 4, 6 – 13, 24, 26 – 33, 44 – 45, and 52 have been rejected as being unpatentable over Ohashi in view of Caputo et al. (U.S. Patent No. 5,778,071) (“Caputo”). These rejections are respectfully traversed.

Claims 4, 6 – 13, 18, and 46 – 48 depend from amended independent claim 1, claims 24, 26 – 33, 39 – 40, and 49 – 52 depend from amended independent claim 21, and claims 44 – 45 and 53 depend from amended independent claim 42.

It is respectfully submitted that claims 18, 39 – 40, 46 – 51, and 53 are allowable over Ohashi, alone, for at least the reasons provided above in support of the allowability of independent claims 1, 21 and 42 over Ohashi.

Further, with respect to claims 4, 6 – 13, 24, 26 – 33, 44 – 45, and 52, it is respectfully submitted that Caputo clearly does not compensate for the above-described deficiencies of Ohashi as a reference against the independent claims. Thus, it is respectfully submitted that claims 4, 6 – 13, 24, 26 – 33, 44 – 45, and 52 are allowable over Ohashi in view of Caputo for at least the reasons provided in support of the allowability of independent claims 1, 21 and 42.

Given the significant technical advantages of the present invention, and the absence of any prior art disclosing or suggesting the claimed authentication arrangement, it is respectfully submitted that there is simply no reason that a person of ordinary skill in the art at the time of the invention would modify any prior art document or "telecommunication authentication standards" in order to arrive at the present invention.

### **Double Patenting**

Claims 1 – 53 have been provisionally rejected on the ground of nonstatutory obviousness-type double patenting over claims 1 – 26 of co-pending Application No. 10/531,429 ("the '429 application") and all pending claims of co-pending Application No. 10/574,808 ("the '808 application").

A single terminal disclaimer based on common ownership, pursuant to MPEP 804.02.IV, is submitted herewith disclaiming the terminal part of the statutory term of any patent granted on the instant application which would extend beyond the expiration dates of the '429 application and the '808 application. It is respectfully submitted that the terminal disclaimer overcomes the provisional nonstatutory obviousness-type double patenting rejections.

Allowance of the application in its present form is respectfully solicited.

Respectfully submitted,

Date: May 21, 2009

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